

### **REMARKS**

Claims 1-25 are pending in the present application. By this Amendment, claim 1 has been amended. Support for the amendment to claim 1 is found at least at page 21, lines 21-22, of the specification. Claim 25 has been added. Support for claim 25 is found at least at page 9, lines 21-23, of the specification. Claims 17-24 have been withdrawn by the Examiner. No new matter has been added.

Claims 1-12 and 14-16 are rejected under 35 U.S.C. § 103(a) as being obvious over US 2001/0021375 to Hössel et al. (hereinafter "Hössel 1").

Claim 1, as amended, recites that the monomer mixture M) is polymerized in an aqueous medium in the presence of at least one polymeric anionic dispersant D). At least these features of the independent claim cannot reasonably be considered to be taught or to have been suggested in Hössel 1.

As appreciated by the Examiner, Hössel 1 fails to teach features corresponding to a polymerization in an aqueous medium in the presence of at least one polymeric anionic dispersant D). However, the Office Action asserts, at the bottom of page 15, that claim 1 could reasonably be interpreted to embrace a polymeric dispersion, which is dispersed in an aqueous medium after the polymer has been formed.

Claim 1 has been amended herewith for clarity to recite, wherein the monomer mixture M) is polymerized in an aqueous medium in the presence of at least one polymeric anionic dispersant D).

Further, the Office Action states that the instant claims are interpreted as product-by-process claims. As such, the burden is shifted to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the product of Hössel 1.

Applicants respectfully submit that the instant product is structurally different from the polymer compositions of Hössel 1 and the other applied citations for at least the reason that the function of a polymer results from its structure. In this case, the instant polymer dispersion

achieves a remarkable reduction in combing force of 60%, relative to the reduction of only 26% for C1, as evidenced by Table 1, page 43, of the specification.

At page 5, lines 1-3, the Office Action states that the burden is shifted to Applicant to demonstrate that the instant polymer dispersion is patentably distinct from the cosmetic and dermatological sunscreen preparations of Hössel 1. Applicants respectfully submit that comparative data between the instant polymer dispersions and the products of the applied citation is currently not available.

Claims 15 and 25 recite an LT (light transmittance value) of at most 30% and at most 5%, respectively.

The Office Action states, at page 5, line 4, that the compositions of Hössel 1 must possess the claimed light transmittance, i.e. that the compositions of Hössel 1 inherently possess the claimed properties. However, as mandated by legal precedence, inherency requires that the recited result or structure must necessarily be obtained not merely that it might be achieved. See *Electra Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 32 USPQ2d 1017 (Fed. Cir. 1994); *In re Oelrich*, 212 USPQ 323 (CCPA 1981) and *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999).

As set forth in MPEP §2112 (IV), “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). This burden has not been met in the Office Action.

Specifically, Hössel 1 teaches, at paragraph [0115] that a colorless high-viscosity polymer solution is obtained. However, such a teaching is at least not inconsistent with a polymer solution that possesses a light-transmittance that is higher than the claimed values. Thus, Hössel 1 does not teach that the products therein necessarily possess the claimed light-transmittances.

Claims 13 is rejected under 35 U.S.C. § 103(a) as being obvious over Hössel 1 in view of WO 2001/062809 to Kim et al.

The Office Action relies on Kim for teaching a polymerization regulator. Kim is not applied in a manner to cure the deficiencies of Hössel 1 discussed above.

Claims 1, 2, 4-6, 8-12, and 15 are rejected under 35 U.S.C. § 103(a) as being obvious over US Patent No. 6,682,725 to Dieing et al.

The application of Dieing fails for the same reasons as discussed above with regard to Hössel 1. In particular, Dieing teaches, at col. 6, lines 62-64, that the novel polymers can be blended with conventional hair cosmetic polymers, which the Office Action considers to correspond to an anionic dispersant as claimed. However, Dieing fails to teach that the novel polymers taught therein are polymerized in the presence of conventional hair cosmetic polymers.

What is more, Dieing teaches, at col. 8, line 61, that the polymer solution of Example 1 is colorless. Accordingly, Dieing fails to teach that the polymer solutions therein necessarily possess the claimed light-transmittances.

Claims 1, 2, 4-6, 8-12, and 15 are rejected under 35 U.S.C. § 103(a) as being obvious over US Patent No. 7,422,735 to Hössel et al. (hereinafter "Hössel 2").

The application of Hössel 2 fails for the same reasons as discussed above with regard to Hössel 1 and Dieing. Specifically, Hössel 2 teaches, at col. 9, lines 20-21, that the polymers according to the invention can also be mixed with traditional polymers. However, Hössel 2 fails to teach that the polymers according to the invention therein are polymerized in the presence of traditional polymers.

Claims 2-16 and 25 are in condition for allowance for at least their respective dependence on an allowable claim 1, as well as for the separately patentable subject matter that each of these claims recite.

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In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 13111-00029-US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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